

Remarks

The above application has again been carefully reviewed in light of the Office Action issued subsequent to the Request for Continued Examination (RCE) and the Rejections as set forth therein as well as the comments of the Examiner which have been duly noted.

The Examiner has withdrawn prior rejections and has now rejected claims 1 through 8 under 35 U.S.C. §103(a) as being unpatentable over the published Japanese Patent Application No. 2-353 U, taken in view of the U.S. Patent of Barbieri 4,004,362, newly cited.

It is the perception of the Examiner that it would be obvious to one of ordinary skill in the art to have provided a cutting line penetrating through the tape body and the release sheet in the same location in the Japanese published application 2-353U, to protect the adhesive while controlling the removal of the backing layer as taught by Barbieri.

The single parent Claim 1 has been amended once again to include an additional feature which is believed to define invention over the cited prior art. The new feature in the claim is that the cutting line **L** can be ruptured there along, so that positioning tab **24** can be separated from the tape body

4 along the cutting line **L**. Thus the cutting line **L** is intended to cut off or separate the positioning tab **24** from the tape body **4** there along.

The newly cited Barbieri patent relates to an adhesive label for attachment to electrical wiring for the purpose of identification during assembling or manufacturing operations. Here the label or marker **10** includes a perforated line **16** formed to pass through an adhesive element **11** and a backing **13** as seen in Figures 1 and 2. It should be noted however, that the perforated line **16** is intended to simply fold the adhesive element **11** there along after the backing **13** is removed from the adhesive element **11** (Figure 6) and not to cut both elements **11** and **13** there along. Accordingly it is not believed that Barbieri teaches or suggests the present invention as recited in amended Claim 1.

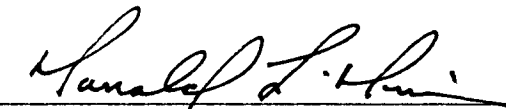
It is believed that the Barbieri patent is from an art that is unrelated and non analogous to the technical field of the present invention and that one skilled in the art would not look to such a field for a suggestion to modify the Japanese Published application. There is no suggestion or motivation to combine the teachings of the two references.

It has long been held that elements of two prior citations cannot be combined when there is no suggestion of such combination anywhere in those references. *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987). See also *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985).

In light of the present amendment to the parent claim and the arguments advanced above, reconsideration of the rejection is respectfully solicited.

Respectfully submitted,

By



Donald L. Dennison
Reg. No. 19,920
Attorney for Applicants
Dennison, Schultz, & Macdonald
1727 King Street
Suite 105
Alexandria, VA 22314
(703) 837-9600 Ext. 15

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